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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,916	09/18/2006	Asim Kumar Sarkar	294-231 PCT/US	4536
23869 7590 06/12/2008 HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791				
EXAMINER				
REDDY, KARUNA P				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
06/12/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/552,916

Applicant(s)

SARKAR, ASIM KUMAR

Examiner

KARUNA P. REDDY

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 10-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 15-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date 1/8/2008
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the amendment filed 2/11/2008. Claims 7 and 8 are amended; and claims 10-14 are withdrawn. Claims 1-9 and 15-16 are currently pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 1-5, 8-9 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over McVay et al (US 3, 902, 596) in view of Duffield et al (US 2003/0108705 A1).

The rejection is adequately set forth in paragraph 7 of office action mailed 10/12/2007.

4. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over McVay et al (US 3, 902, 596) in view of Duffield et al (US 2003/0108705 A1) as applied to claim 1 above, and further in view of Amo et al (EP 0 668 098 A1).

The rejection is adequately set forth in paragraph 8 of office action mailed 10/12/2007.

Response to Arguments

5. Applicant's arguments, see 5, lines 17-24, filed 2/11/2008, with respect to objection have been fully considered and are persuasive. The objection of claims 7-8 has been withdrawn in view of the amendment.
6. Applicant's arguments filed 2/11/2008 have been fully considered but they are not persuasive. Specifically, applicant argues that (A) McVay et al teach use of a resin soluble envelope and an explosively decomposable polymerization initiator catalyst wherein the catalyst is stabilized using a liquid vehicle, such as mineral oil. This is in contrast to the present invention that does not require a liquid vehicle for stabilization. The stabilization is improved by using the initiator in powder or granule form. Thus McVay et al teach away from the present invention; (B) McVay teaches away from the claimed invention by stating that the catalyst disperses throughout the resin. In contrast, both the initiator and the container of the claimed invention readily dissolve when exposed to the polymerization system. Thus, the polymerization reaction is initiated more quickly than in McVay et al; (C) catalyst of McVay et al which does not dissolve, is initiated on the surface of catalyst particles. Consequently, the McVay et al system requires larger quantities of the catalyst, and the polymerization reaction will be initiated at a slower rate compared to the polymerization system of present invention; (D) Duffield et al constitutes non-analogous art. Duffield et al relates to water-soluble containers for a household product. There is no reason to combine Duffield et al with McVay et al. Duffield et al does not teach or suggest that the water-soluble containers can be used to hold polymerization initiators; (E) neither McVay et al nor Duffield et al teach or suggest a polymerization initiator system including a water-soluble container and a water-soluble azo-initiator inside the container.

With respect to (A), it is noted that present claims use the transitional phrase "comprising" which is open ended or inclusive and does not exclude additional, unrecited elements such as liquid vehicle, which is used for stabilization in the cited reference of McVay et al. Furthermore, features upon which applicant relies (i.e., "does not require a liquid vehicle for stabilization", "the stabilization is improved by using the initiator in powder or granule form") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With respect to (B) and (C), it is noted that present claims are directed to polymerization initiator system. The disclosure of McVay et al combined with teachings of Duffield et al meet all the limitations of present claims. Applicant's attention is also drawn to cited reference of McVay et al (col. 1, lines 8-13) wherein it discloses an additive package for holding additives, which package is soluble in the resin for formulation in which the additives are to be dissolved. Furthermore, features upon which applicant relies (i.e., "initiator and the container dissolve readily when exposed to the polymerization system", "because initiator of the present invention dissolves, the polymerization reaction is initiated more quickly than in Mcvay et al", "catalyst of McVay et al which does not dissolve, is initiated on the surface of the catalyst particles", and "the polymerization reaction will be initiated at a slower rate compared to the polymerization system of present invention") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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With respect to (D), court held that the selection of a known material based on its suitability for its intended use (i.e. Duffield et al teach a container that is water soluble) supported a prima facie obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945).

With respect to (E), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references i.e. a combination of McVay et al and Duffield et al. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to KARUNA P. REDDY whose telephone number is (571)272-6566.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Karuna P Reddy/
Examiner, Art Unit 1796

/VASUDEVAN S. JAGANNATHAN/
Supervisory Patent Examiner, Art Unit 1796